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09/874,450	06/05/2001	David E. Allport	239/008-C1	6282

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DISCOVISION ASSOCIATES
INTELLECTUAL PROPERTY DEVELOPMENT
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EXAMINER
NGUYEN, JIMMY H

ART UNIT	PAPER NUMBER
2673	

DATE MAILED: 04/08/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
Office Action Summary	09/874,450	ALLPORT, DAVID E.
	Examiner	**Art Unit**
	Jimmy H. Nguyen	2673

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on <u>17 January 2003</u> .

2a) ☐ This action is **FINAL**.   2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☐ Claim(s) <u>1-9,11-14,17-24,27,28,33-37,45-48 and 59-66</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) <u>1-9,11-14,17-24,27,28,33-37,45-48 and 59-66</u> is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.

    If approved, corrected drawings are required in reply to this Office action.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a) ☐ All b) ☐ Some * c) ☐ None of:

      1. ☐ Certified copies of the priority documents have been received.

      2. ☐ Certified copies of the priority documents have been received in Application No. _____ .

      3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

    a) ☐ The translation of the foreign language provisional application has been received.

15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)		4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .	
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)		5) ☐ Notice of Informal Patent Application (PTO-152)	
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .		6) ☐ Other:	

DETAILED ACTION.

Request for Continued Examination

1.   A request for continued examination under 37 CFR 1.114, including the fee set forth in

37 CFR 1.17(e), was filed in this application after final rejection. Since this application is

eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e)

has been timely paid, the finality of the previous Office action has been withdrawn pursuant to

37 CFR 1.114. Applicant's submission filed on January 17th, 2003 has been entered. Claims 1-9,

11-14, 17-24, 27, 28, 33-37, 45-48 and 59-66 are currently pending in the application. An action

on the RCE follows:

2.   It is noted to the applicant that the application does not disclose expressly the specific

methods to clearly support the claimed methods, e.g., there are at least a drawing such as a flow

chart (see 37 CFR 1.83(a)) and a corresponding description to illustrate all the steps recited in the

claimed method, so as to enable any person skilled in the art to which it pertains, or with which it

is most nearly connected, to make and use the invention.

Drawings

3.   The drawings are objected to under 37 CFR 1.83(a). **The drawings must show all**

features of the invention specified in the claims. Therefore, the following claimed limitations

must be shown or the feature(s) canceled from the claim(s): all steps recited in method claims 1,

4, 8, 11, 27, 45, 48, 60, 61 and 64-66 must be shown in the drawing, e.g., a **flow chart** or the

like, for illustrating all steps recited in these method claims. Furthermore, the drawing must show

the claimed features, "a system state" and "a previous state", as recited in claims 1 and 17, "data

representing available functions to be executed" as recited in claims 4, 8, 11 and 48, "the

previous used state of the first user comprises one of a screen last viewed, time of day or night

the first user logged-on or logged-off, a content data displayed, a selection made and a

navigation history used" as recited in claim 13, "an initial system state" recited in claim 22, "a

representation of the system state" recited in claim 23, "a default state" recited in claim 24, "a

first set of functionality", "a first system state", "a second system state" and "at least one

factor", as recited in claim 27, "a default state" recited in claim 28, "a category of use" recited in

claim 34, "a subject matter of activity within a category of use" recited in claim 35, "a second set

of functionality" recited in claim 36, "a power down state" recited in claim 37, "a group user

state" recited in claim 45, "a first user state" recited in claim 60, "a factor including a class, a

log-in time, a category of use, a subject matter of user of the first user", "a default state", "a

power down" and "a second user state", recited in claim 61. No new matter should be entered.

**A proposed drawing correction or corrected drawings are required in reply to the
Office action to avoid abandonment of the application. The objection to the drawings will
not be held in abeyance.**

Claim Objections

4.   Claim 36 is objected to because of the following informalities: line 3, --state-- should be

inserted immediately after "system", so as to be consistent with the claimed feature in line 1.

Appropriate correction is required.

5.   Claim 61 is objected to because of the following informalities: line 6, --of the user--

should be inserted immediately after "class", and , --activity-- should be inserted immediately

after "of user", so as to be consistent with the specification, page 14, lines 18-21. Appropriate

correction is required.

6.   Claim 64 is objected to because of the following informalities: line 1, "method" should

be changed to --controller--, so as to be consistent with the claim 24. Appropriate correction is

required.

Claim Rejections - 35 USC § 112

7.   The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making
> and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it
> pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode
> contemplated by the inventor of carrying out his invention.

8.   Claims 1-9, 11-14, 45-48, 59-61, 63, 65 and 66 are rejected under 35 U.S.C. 112, first

paragraph, as containing subject matter which was not described in the specification in such a

way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the

application was filed, had possession of the claimed invention.

As per claims 1-9, 11-14, 65 and 66, the application does not disclose the method of for

accessing functionality of a consumer comprising accessing a second state of a controller,

receiving bio-metric input of a first user, establishing a system state of the controller and

providing access to functionality of the system state, as recited in independent claim 1. The

original disclosure, specifically from page 6, line 16 through page 7, line 2, discloses a method

for controlling multi-user access to functionality of consumer devices comprising supplying bio-

metric input of a first user, providing access to the functionality of consumer devices, supplying

bio-metric input of a second user, and providing access to the functionality of consumer devices,

and specifically page 7, lines 7-13, discloses a method for controlling multi-user access to

functionality of consumer devices comprising providing a first user access to a first set of

functionality of consumer devices, said controller in a first state associated with the identify of

the first user, and switching to a second state after being in the first state, said switching to the

second state occurring at a time dependent upon at least the identity of the first user. However,

the disclosure, specifically drawing, does not disclose expressly the method comprising all the

steps in the manner as recited in independent claim 1 above. Additionally to claims 4, 8 and 11,

the step of displaying on the display area data representing available functions to be executed

following the step of providing access to functionality of the system state is not properly

described in the disclosure. Additionally to claim 65, the step of locking access to functionality

of the system state after a time-out process following the step of providing access to functionality

of the system state is not properly described in the disclosure. Additionally to claim 66, the step

of manually logging-off access functionality of the system state following the step of providing

access to functionality of the system state is not properly described in the disclosure.

As per claims 45-48, 59, 60 and 63, the application does not disclose the claimed method

of controlling multi-user access to functionality of a consumer device comprising all the steps in

the manner as recited in independent claim 45. The disclosure, specifically from page 13, line 19

through page 14, line 10, discloses that a group user such as "USER1+USER2" use the

controller. However, the disclosure does not provide any specific method as recited in claim

above. Moreover, the mentioned disclosure does not disclose expressly the claimed feature,

"establishing a group user in response to a first bio-metric input **and** a second bio-metric input

from said first and second users respectively", lines 5-6, i.e., the mentioned disclosure only

teaching establishing a group user in response to a first bio-metric input from the first user **or** a

second bio-metric input from the second user. Additionally to claim 48, the mentioned disclosure

does not disclose expressly the method including the step of displaying on the display area data

representing available functions to be executed.

As per claims 61 and 62, the application does not disclose the claimed method of

controlling multi-user access to functionality of a consumer device comprising the steps in the

manner as recited in independent claim 61. The disclosure, specifically at page 14, lines 11-23,

discloses that another feature that **may** be incorporated into the field of controller technology is

the use of time-out algorithms which may incorporate factors such as the identity or class of the

user, the time of day or night, the category of use, the category or subject matter of activity

within a category of use, and during the time-out of the controller, the controller may enter into a

default state, power down or switch to a state representing another user's preferences and/or

privileges. However, the disclosure does not contain such description and details the specific

method comprising the steps of logging on to a controller, and the step of incorporating an

algorithm into the controller, as claimed. Moreover, regarding to the claimed feature, "an

algorithm for determining an occurrence of a time-out", see claim 61, lines 4-5, the disclosure

does not disclose expressly the algorithm for determining an occurrence of a time-out.

9.   Claims 13, 23, 24, 27, 28, 33-37 and 64 are rejected under 35 U.S.C. 112, first paragraph,

as containing subject matter which was not described in the specification in such a way as to

enable one skilled in the art to which it pertains, or with which it is most nearly connected, to

make and/or use the invention.

Regarding to claim 13, the disclosure, when filed, does not contain sufficient information

regarding to the claimed feature, "the previous used state of the first user comprises one of a

screen last viewed, time of day or night the first user logged-on or logged-off, a content data

displayed, a selection made and a navigation history used", of claim 13, so as to enable one

skilled in the pertinent art to make and use the claimed invention. The disclosure, specifically at

page 12, lines 1-4, only discloses as much as recited in the claim above. However, the disclosure

does not contain such drawing, description and details the state of time of day or night, the state

of the first user logged-on or logged-off and etc., as recited in claim above, so as to enable one

skilled in the pertinent art to make and use the claimed invention. See MPEP 608.01(p).

Regarding to claim 23, the disclosure, when filed, does not contain sufficient information

regarding to the claimed feature, "the controller is programmed to display a representation of the

system state on the display", of claim 23, so as to enable one skilled in the pertinent art to make

and use the claimed invention. The disclosure, specifically at page 2, lines 10-13, only discloses

the controller may be programmed. However, the disclosure does not contain such description

and details how the controller is programmed to display a representation of the system state on

the display, as recited in claim above.

Regarding to claims 24 and 64, the disclosure, when filed, does not contain sufficient

information regarding to the claimed feature, "the system state represents a default state if the

first user is a guest user", of claim 24, so as to enable one skilled in the pertinent art to make and

use the claimed invention. The disclosure, specifically at page 15, first paragraph, only discloses

that the default state may be desirable for guests and other users **not known** to the controller.

However, the disclosure does not contain such description and details how the controller is

programmed to recognize the first user being a guest. Furthermore, the independent claim 17,

lines 4-6, recites "the controller, upon log-on by a first user, is programmed to enter a previous

used state by the first user ... the first user", i.e., the first user must be known by the controller in

order to allow the log-on by the first user. Accordingly, the disclosure and the claimed invention

of claim 24 above are not consistent, so as to so as to enable one skilled in the pertinent art to

make and use the claimed invention.

Regarding to claim 27, 28 and 33-37, the disclosure, when filed, does not contain

sufficient information regarding to the claimed features, "switching to a second system state

from the first system state **at a time calculated by an algorithm** which incorporates at least one

factor other than the passage of a certain amount of time", of independent claim 27, "the at least

one factor is a category of use associated with the consumer device" additionally recited in claim

34, "the at least one factor is a subject matter of activity within a category of use associated with

the consumer device" as additionally recited in claim 35. The disclosure, specifically at page 14,

lines 11-23, discloses that another feature that **may** be incorporated into the field of controller

technology is the use of time-out algorithms which incorporate factors other than merely the

passage of a certain amount of time, and the time-out algorithm may incorporate factors such as

the category of use, a subject matter of activity within a category of use, power down, the class

of the user, the time of day or night, and etc.. However, the disclosure does not contain such

description and details how the controller switches from one state to another state at a time

calculated by an algorithm, i.e., how the calculated time relates with the category of use, a

subject matter of activity within a category of use, power down, the class of the user, the time of

day or night, and etc., and how the algorithms incorporating the category of use, a subject matter

of activity within a category of use, power down, the class of the user, the time of day or night,

and etc., may be incorporated in the controller.

10.   Due to the rejections under 35 USC 112, first paragraph above, the following art

rejections are based as best understood by the examiner.

Claim Rejections - 35 USC § 103

11.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

12.   Claims 1-4, 9, 11-14, 17, 18, 20-24, 27, 28, 33-37, 45-48 and 59-66 are rejected under 35

U.S.C. 103(a) as being unpatentable over Park (USPN: 5,990,803, cited in IDS filed 06/05/2001

entered as paper No. 2) in view of Merjanian (USPN: 5,920,642, cited in IDS filed 06/05/2001

entered as paper No. 2) and further in view of Applicant's Admitted Prior Art, herein after

AAPA.

        As per claims 1-4, 9, 11-14, 17, 18, 20-23, 27, 33-37, 45-48, 59-61, 63, 65 and 66, Park

discloses a hand-held controller and an associated method for accessing functionality of

consumer devices such as a television and other appliances, the controller (see fig. 1) comprising

a fingerprint recognizer (120) (corresponding to the claimed bio-metric input component) for

receiving a fingerprint pattern from a user, a display (150) (corresponding to the claimed

graphical display) for displaying on the display data representing available functions to be

executed, and a menu selector (110) comprising a menu key and a selection key (col. 2, lines 33-

37) (corresponding to the claimed plurality of physical actuating buttons), wherein an access to

the functionality of the consumer devices by the use of the controller is dependent upon the bio-

metric input from the authorized user (fig 2). Park further discloses the fingerprint recognizer

including a memory EPROM for storing initially fingerprint pattern of the authorized person

(col. 2, lines 28-29, col. 3, lines 1-15), but Park is silent on a number of users. Accordingly, Park

discloses the claimed subject matter except for accessing to functionality by a number of users

and establishing the states of the controller when using by different users or upon log-on by a

first user.

However, Merjanian discloses a related hand-held controller, wherein a first user may

allow to access a first set of functionality upon an identity of the first user determined by the

controller based upon input to the controller from the first user, a second user may allow to

access a second set of functionality upon an identity of the second user determined by the

controller based upon input to the controller from the second user and so on (column 3, lines 27-

53).

It would have been obvious to one of ordinary skill in the art to utilize the capability of

multi-user access to functionality of the consumer device, as taught by Merjanian (col. 3, lines

27-53) in the hand-held controller of Park because this would allow a plurality of the users

accessing to functionality of consumer device. However, the combination of Park and Merjanian

does not disclose expressly establishing the states of the controller when using by different users

or upon log-on by a first user, as claimed.

However, AAPA discloses that a system, which inherently comprises a controller

programmed to present a user upon log-on thereto, a system state being the previous system state

of the controller that was in effect at the end of a previous use of the controller by the user, is

well-known to one of ordinary skill in the art (page 3, line 20 through page 4, line 7). Further, for

first example, the first user previously caused the controller establishing a previous system state,

e.g., a state of displaying a letter "A", then the second user accessed the controller without a need

of log-on (since the first user did not log off the controller) and caused a letter "B" displayed on

the display, **so as to cause the controller having a system state, a state of displaying a letter**

"B", different than the previous system state, i.e., a state of displaying a letter "A". After

that, the second user manually restored the first user's previous state, i.e., a state of displaying a

letter "A", and locked the controller either manually or automatically, after some delay time.

When the first user logs back on to the controller, the controller establishes **a current system**

state, which is the same as the previous state, i.e., a state of displaying a letter "A".

Accordingly, AAPA discloses the claimed feature, "establishing a current system state of the

controller similar to or being the previous system state" as recited in the claims. It would have

been obvious at the time of the invention was made to utilize of AAPA's teachings, as discussed

above, in the hand-held controller of Park in view of Merjanian, i.e., programming the controller

capable of establishing a system state being the previous system state of the controller that was in

effect at the end of a previous use of the controller by the user, because this would allow the user

immediately logging back to the previous state at any time, thereby avoiding the unnecessary

waste time.

Regarding to claims 24, 28, 62 and 64, Merjanian further teaches the controller having a

state to prevent use of the controller for accessing pay-per-view programming (col. 3, lines 39-

47). These claims are therefore rejected for the reason as set forth above.

13.   Claims 5-8 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Park in

view of Merjanian and AAPA, and further in view of Sirbu (USPN: 6,070,796, cited in IDS

filed 06/05/2001 entered as paper No. 2).

As per claims above, as described above, Park in view of Merjanian and AAPA discloses the claimed subject matter except that the bio-metric input component is a microphone and the bio-metric input comprises the voice data, as claimed.

However, Sirbu discloses a related hand-held controller comprising a bio-metric input component which is a microphone (MIC) and a bio-metric input to a microphone comprising voice data (fig. 7, col. 7, line 48 – col. 8, line 32). It would have been obvious to one of ordinary skill in the art at the time of the invention was made to substitute the fingerprint pad of Park or to provide the hand-held controller of Park with the microphone of Sirbu, because this would provide a user, especially for a user having an injured finger, another convenient means to control the access of the functionality of the consumer device, as taught by Sirbu (col. 29-32).

Response to Arguments

14.   Applicant's argument filed "In the present invention, the drawings ... are not necessary for the understanding of the subject matter sought to be patented ... drawings", has been fully considered but it is not persuasive, because in the instant case, the original disclosure, without the drawings, specifically from page 6, line 16 through page 7, line 2, discloses a method for controlling multi-user access to functionality of consumer devices comprising supplying bio-metric input of a first user, providing access to the functionality of consumer devices, supplying bio-metric input of a second user, and providing access to the functionality of consumer devices, and specifically page 7, lines 7-13, discloses a method for controlling multi-user access to functionality of consumer devices comprising providing a first user access to a first set of functionality of consumer devices, said controller in a first state associated with the identify of the first user, and switching to a second state after being in the first state, said switching to the

second state occurring at a time dependent upon at least the identity of the first user. However,

the claimed methods comprise many other steps which are not disclosed in the above mentioned

disclosure, and the original disclosure does not describe the order of steps in the claimed

methods, so as to enable one skilled in the art to which it pertains, or with which it is most nearly

connected, to make and/or use the invention and/or to reasonably convey to one skilled in the

relevant art that the inventor(s), at the time the application was filed, had possession of the

claimed invention. Furthermore, under 37 CFR 1.83(a), the drawings must show all features of

the invention specified in the claims or the feature(s) canceled from the claim. For the above

reasons, it is believed that the drawing objection should be sustained.

15.   Applicant's argument with respect to the rejection under 35 USC 112, first paragraph,

please see the new rejection above.

16.   Applicant's argument filed "Park, Merjanian and AAPA, taken alone or in combination,

do not disclose, suggest, or render obvious establishing a system state being a previous used state

by the first user", has been fully considered but it is not persuasive, because as discussed in detail

rejection above, AAPA further discloses that a system, which inherently comprises a controller

programmed to present a user upon log-on thereto, a system state being the previous system state

of the controller that was in effect at the end of a previous use of the controller by the user, is

well-known to one of ordinary skill in the art (page 3, line 20 through page 4, line 7). Further, for

first example, the first user previously caused the controller establishing a previous system state,

e.g., a state of displaying a letter "A", then the second user accessed the controller without a need

of log-on (since the first user did not log off the controller) and caused a letter "B" displayed on

the display, **so as to cause the controller having a system state, a state of displaying a letter**

"B", different than the previous system state, i.e., a state of displaying a letter "A". After

that, the second user manually restored the first user's previous state, i.e., a state of displaying a

letter "A", and locked the controller either manually or automatically, after some delay time.

When the first user logs back on to the controller, the controller establishes **a current system**

state, which is the same as the previous state, i.e., a state of displaying a letter "A".

Accordingly, AAPA discloses the claimed feature, "establishing a current system state of the

controller being a previous system state". For the above reasons, it is believed that the rejections

under 35 USC 103(a) should be sustained.

Conclusion

17.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Jimmy H. Nguyen whose telephone number is (703) 306-5422.

The examiner can normally be reached on Monday - Thursday, 8:00 a.m. - 5:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Bipin Shalwala can be reached at (703) 305-4938.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:

(703) 872-9314 (for Technology Center 2600 only)

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive,

Arlington, VA, Sixth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application or proceeding

should be directed to the Technology Center 2600 Customer Service Office whose telephone

number is (703) 306-0377.

JHN
April 6, 2003

Amare Mengistu
Amare Mengistu
Primary Examiner